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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,978	03/15/2001	Yoshinori Ohta	5-027US-FF	3790

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MCGINN & GIBB, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,978

Applicant(s)

OHTA, YOSHINORI

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-14, 16, 17, and 19-24 have been examined.

Response to Amendment/Argument

2. Applicant is of the opinion that the prior art does not teach Applicant's claimed invention. Specifically, Applicant asserts that the combined teachings of Freedman and Hartman et al. do not teach or suggest "a determination unit for determining, on the basis of the correspondence data, which of the plurality of second client computers is affiliated with the orderer specified by the orderer data received by said first receiving unit". The Examiner respectfully disagrees. Freedman teaches a system for ordering print related goods and services, wherein said order comprises a user choice of print facility for fulfilling said order ('829, column 10, lines 19-32). To one of ordinary skill, Hartman et al. provide a teaching for more efficiently entering order data by storing order data to be used for future orders in memory ('411, column 10, lines 15-35), such as a print facility ('829, figure 1A). A feature at least suggested by Freedman ('829, column 8, lines 20-25). Further, this creates an "affiliation" between the orderer and the print facility, the affiliation being print facilities that the orderer has ordered from (note this also applies to claim 33).

Applicant has also added claims 25-33. Claims 25-32 are directed to data stored at an apparatus. However, it has been held that in order for a claimed structure to differentiate from the prior art, the differences have to be found in the respective structures and not functionality (*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997). Therefore, as both Freedman and Hartman et al. store data in databases the prior art teach Applicant's apparatus. Regarding databases, the Examiner takes Official Notice that relational databases and data models (e.g. a table that links data by a unique identifier such as an account number, social security number or ID) are old and well known.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-7, 11-14, 16, 17, and 19-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 in view of Hartman et al., U.S. Patent No. 5,960,411.

As per claims 1-7, 11-14, 16, 17, and 19-24, Freedman teaches an image ordering system comprising:

- a server, first client computer and a second computer connected via a communication network (figures 1A-B)
- a first client computer comprising: an input unit for specifying an image and a transmitting unit for transmitting to a server said image specifying data (abstract; figures 1A-B)
- server comprising: receiving unit for receiving image specifying data, transmitting unit for image and orderer specifying data to a second client computer (abstract; figures 1A-B; column/line 7/62-8/35)
- a server with an image database for storing thumbnail images (column/line 8/55-9/63)
- a server with calculation unit that calculates an estimated fee for printing an image based on image specifying data, transmitting the fee (e.g. of orderers affiliated with a second client computer) to a client computer (column/line 9/63-10/35)
- a first client computer that receives a fee estimate from the server and an alerting unit for giving notice of the estimate (column/line 9/63-10/35)
- second client computer comprising: receiving unit for receiving image specifying and orderer data, printer controller, and an alerting unit (abstract; figures 2B; column 8, lines 1-20; column 10, lines 27-35)

- a first setting unit for setting at least one of a lab affiliated with an agency and an orderer affiliated with a lab and for transmitting this data to a server (column/line 7/62-8/14; column 10, lines 15-35)

Freedman also teaches an image ordering system that comprises a server transmitting order parameters to a first and second client computers (column 10, lines 15-35). Freedman teaches a second client computer giving notice of information received regarding received data such as acceptance of a print job and responses to inquiries regarding job status (column 10, lines 31-54).

Freedman doesn't specifically recite transmitting fee data or orderer specifying data to a second client computer. However, Freedman recites the server transmitting image specifying data and all other parameters and other information to second client computer (column 10, lines 27-35), hence, it would have been obvious to one of ordinary skill for the server to send first client identity data and/or a replica of the receipt (e.g. specifying data, prices) sent to the first client computer (column 10, lines 33-35) to facilitate the matching and resolution, in the case of discrepancies, of orders. However, Freedman does not specifically storing order data for use in subsequent orders. Hartman et al. teach a network ordering system comprising a server with memory for retaining client order preferences for use in subsequent orders and a determining unit fulfilling orders based on the preference data (abstract). Therefore it would have been obvious to

one of ordinary skill to combine the teachings of Freedman and Hartman et al. in order to make the ordering process more efficient.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 and Hartman et al., U.S. Patent No. 5,960,411, as applied to claim 5 above, and in further view of Greulich et al., U.S. Patent No. 6,018,338.

As per claims 8-10, Freedman teaches a network ordering method and system that connects over a communication link a server, a first client computer and a second client computer and transmits image specifying data and all other parameters and other information between the parties (abstract; figures 1A-2B; column 10, lines 27-35). Freedman also teaches a first client computer providing a server with payment data (column 8, lines 1-10) and a second client computer accepting the order (column 10, lines 30-35). The latter, suggests, to one of ordinary skill, a verification unit and that a second client computer may choose not to accept the order if the order data and all other parameters and other information was found unacceptable. Hartman et al. teach a network ordering system comprising a server with memory for retaining client order preferences for use in subsequent orders and a determining unit fulfilling orders based on the preference data (abstract; figures 1C, 3, 4 and 8A-C; column 3, lines 58-66; column 4, lines 30-67; column/line 5/55-6/21; column 6, lines 45-52). However,

neither Freedman nor Hartman et al. specifically recite transmitting fee data to a third client computer. Greulich et al. teach a network ordering system and method that comprises a third party for verifying a first client ability to pay for a service provided by the second client computer (figure 1; column 5, lines 45-51). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman, Hartman et al., and Greulich et al. in order to prevent fraud.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

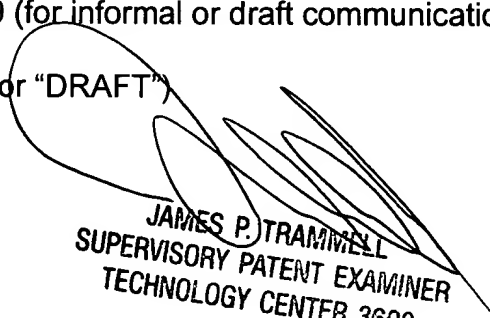
(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

May 20, 2005


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600